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14 Attorneys for IN-N-OUT BURGERS, a California Corp.

15 UNITED STATES DISTRICT COURT
16
17 NORTHERN DISTRICT OF CALIFORNIA – SAN JOSE DIVISION

18 IN-N-OUT BURGERS, a California
19 Corporation,

20 Plaintiff,

21 v.

22 SAI M. ONG, an individual d/b/a
23 “IN N OUT SMOG CHECK,” BO
24 TRAN, an individual d/b/a “IN &
25 OUT SMOG CHECK,” PHI L. LE,
26 an individual d/b/a “IN-N-OUT
27
28

Case No. **05453 JL**

**COMPLAINT FOR TRADEMARK
INFRINGEMENT**

JURY TRIAL DEMANDED

1 SMOG CHECK,” MAN Q. DINH,
2 an individual d/b/a “IN N OUT
3 SMOG CHECK,”

4 Defendants.
5

6
7 Plaintiff IN-N-OUT BURGERS, a California Corporation, (herein after “IN-
8 N-OUT BURGERS”), by and through its undersigned counsel, hereby files its
9 Complaint against Defendants SAI M. ONG, an individual d/b/a “IN N OUT
10 SMOG CHECK”, located at 226 Phelan Avenue #F, San Jose, California 95112;
11 BO TRAN, an individual d/b/a “IN & OUT SMOG CHECK”, located at 1295 West
12 San Carlos Street, San Jose, California 95126; PHI L. LE, an individual d/b/a “IN-
13 N-OUT SMOG CHECK”, located at 490 Keyes Street, San Jose, California 95112;
14 and MAN Q. DINH, an individual d/b/a “IN N OUT SMOG CHECK”, located at
15 735 South 1st Street, Unit A, San Jose, California 95113 (collectively
16 “Defendants”). In support of its Complaint, Plaintiff IN-N-OUT BURGERS
17 alleges as follows:

18 1. This action concerns Defendants’ Trademark Infringement and
19 Unfair Competition under The Lanham Act, Trademark Infringement and Unfair
20 Competition under California Statutory and Common Law, and Trademark Dilution
21 under California Law.

22 **PARTIES**

23 2. Plaintiff IN-N-OUT BURGERS is a California corporation with its
24 principal place of business in Irvine, California.

25 3. Defendants SAI M. ONG, BO TRAN, PHI L. LE, and MAN Q. DINH,
26 individuals, are California residents who, in concert or alone, own and operate
27 emissions control and smog checking service centers in California doing business
28 under the trade names “IN-N-OUT SMOG CHECK”, “IN N OUT SMOG

1 CHECK", "IN AND OUT SMOG CHECK" and/or "IN & OUT SMOG CHECK."
2 Defendants reside and/or have business addresses at the following locations:

3 a. Upon information and belief, Defendant SAI M. ONG
4 is an individual residing at 2555 Glen Anna Way, San Jose, California 95148 and
5 doing business as "IN N OUT SMOG CHECK" located at 226 Phelan Avenue
6 #F, San Jose, California 95112.

7 b. Upon information and belief, Defendant BO TRAN is
8 an individual residing at 2555 Glen Anna Way, San Jose, California 95148 and
9 doing business as "IN & OUT SMOG CHECK" located at 1295 West San Carlos
10 Street, San Jose, California 95126.

11 c. Upon information and belief, Defendant PHI L. LE is
12 an individual residing at 3114 Dakan Court, Unit #3, San Jose, California 95136
13 and doing business as "IN-N-OUT SMOG CHECK" located at 490 Keyes Street,
14 San Jose, California 95112.

15 d. Upon information and belief, Defendant MAN Q.
16 DINH is an individual residing at 3114 Dakan Court, Unit #3, San Jose,
17 California 95136 and doing business as "IN N OUT SMOG CHECK" located at
18 735 South 1st Street, Unit A, San Jose, California 95113.

19 4. Upon information and belief, the individual defendants work together
20 and operate their businesses as a group. Accordingly, the individual defendants and
21 their businesses are referred to collectively herein as "IN-N-OUT SMOG CHECK"
22 or "Defendants."

23 **JURISDICTION AND VENUE**

24 5. This Court may exercise jurisdiction over each of the Defendants
25 because each Defendant regularly transacts business in California, and the causes of
26 action alleged herein arose in whole or in part in California.
27
28

1 6. This Complaint alleges claims under the Lanham Act, making
2 jurisdiction proper in this Court pursuant to Title 28 U.S.C. §§ 1331, 1338, and
3 1367. This Complaint alleges claims under §§32 and 43 of the Lanham Act. The
4 Complaint also alleges State Law claims under California Law that are so related to
5 the Federal Question Claim under The Lanham Act that they form part of the same
6 case and controversy, thereby making the exercise of Supplemental Jurisdiction
7 under Title 28 U.S.C. § 1367 appropriate.

8 7. Venue is proper in this District pursuant to Title 28 U.S.C. § 1391(b)
9 because each of Defendants resides within this Judicial District and conducts
10 substantial business in this Judicial District.

11 8. Venue also is properly laid in this Judicial District pursuant to Title 28
12 U.S.C. § 1391(b) on the ground that the infringing acts alleged herein arose, in
13 whole or in part, within this Judicial District. Defendants advertise goods and
14 services bearing the infringing Trademark in this Judicial District.

15 **BACKGROUND – THE BUSINESS OF PLAINTIFF**

16
17 9. Long prior to the acts complained of herein, IN-N-OUT BURGERS
18 adopted and commenced use of the mark “IN-N-OUT”. IN-N-OUT BURGERS
19 has been engaged in the business of providing specially-prepared sandwiches to
20 consumers in restaurants since at least as early as 1948.

21 10. IN-N-OUT BURGERS currently has over 200 locations throughout
22 California and the southwestern United States, and plans to expand its restaurant
23 operations to other states.

24 11. Since at least as early as 1960, IN-N-OUT BURGERS has used the
25 mark “IN-N-OUT” in interstate commerce in connection with its advertising,
26 promotion, offering to provide, and providing specially-prepared sandwiches and
27 other goods and services to consumers both in its restaurants and through its
28 automobile drive-through windows.

12. IN-N-OUT BURGERS owns all right, title, and interest in and to the Mark "IN-N-OUT," and has obtained Federal Trademark and Service Mark Registrations for the Mark "IN-N-OUT" for a wide range of food and other products, including, inter alia, hamburger sandwiches and cheeseburger sandwiches, French fried potatoes, hot coffee, milkshakes, bumper stickers, backpacks, and coffee mugs. IN-N-OUT BURGERS' Federal Trademark and Service Mark Registrations for the mark "IN-N-OUT" include:

U.S.P.T.O.			
<u>MARK</u>	<u>REGISTRATION</u> <u>No.</u>	<u>CLASS</u>	<u>DESCRIPTION OF SERVICES OR GOODS</u>
IN-N-OUT	2217307	IC 014	Watches
		IC 016	Decals in the nature of bumper stickers; publications in the nature of house organs; gift certificates.
		IC 018	Backpacks
		IC 021	Coffee mugs and thermal mugs
		IC 025	Shirts, baseball caps, letterman's jackets, and cooks aprons.
IN-N-OUT	2285823	IC 042	Computer services, namely, providing data bases in the field of restaurant services and in the field of retail and mail order merchandising services.
IN-N-OUT	1525982	IC 032	Lemonade and soft drinks for consumption on or off the premises.
		IC 030	Hamburger sandwiches and cheeseburger sandwiches, hot coffee, and milkshakes for consumption on or off the premises.
		IC 029	Milk and French fried potatoes for consumption on or off the premises.

1			IC 042	Restaurant services and carry-out restaurant services.
2				
3	IN-N-	1522799	IC 029	Milk and French fried potatoes for consumption on or off the premises.
4	OUT			
5			IC 030	Hamburger sandwiches and cheeseburger sandwiches, hot coffee, and milkshakes for consumption on or off the premises.
6				
7				
8			IC 032	Lemonade and soft drinks for consumption on or off the premises.
9				
10			IC 042	Restaurant services and carry-out restaurant services.
11				
12	IN-N-	1101628	IC 029	Milk and French fried potatoes for consumption on or off the premises.
13	OUT			
14			IC 032	Lemonade and soft drinks for consumption on or off the premises.
15				
16	IN-N-	1085163	IC 042	Restaurant services and carry-out restaurant services.
17	OUT			
18	IN-N-	1101638	IC 030	Cheeseburgers, hamburgers, hot coffee and milkshakes for consumption on or off premises.
19	OUT			

20 IN-N-OUT BURGERS' seven (7) Federal Service Mark and Trademark
 21 Registrations relating to these services and products are attached hereto as Exhibits
 22 "A" through "G".

23 13. In addition, IN-N-OUT BURGERS has been engaged in the interstate
 24 financial sponsorship of automobiles and the automobile racing industry since at
 25 least as early as 1985. IN-N-OUT BURGERS owns all right, title, and interest in
 26 and to the mark "IN-N-OUT BURGERS" and "IN-N-OUT BURGERS
 27 FOUNDATION" to the following Federal Service Mark Registrations relating to
 28

1 the interstate financial sponsorship of automobiles and the automobile racing
2 industry:

<u>MARK</u>	<u>U.S.P.T.O. REGISTRATION No.</u>	<u>CLASS</u>	<u>DESCRIPTION OF SERVICES OR GOODS</u>
IN-N-OUT BURGERS	2291183	IC 036	Financial Sponsorship of race cars and race car drivers
IN-N-OUT BURGERS FOUNDATION	2121178	IC 036	Financial Sponsorship of race cars and race car drivers
IN-N-OUT BURGERS FOUNDATION	2035491	IC 036	Financial Sponsorship of race cars and race car drivers

12 14. IN-N-OUT BURGERS' three (3) Federal Service Mark Registrations
13 relating to the interstate financial sponsorship of automobiles and the automobile
14 racing industry are attached hereto as Exhibits "H" through "J".

15 15. IN-N-OUT BURGERS makes use of its ten (10) Registered Marks in
16 interstate commerce by displaying its Registered Marks on product packaging,
17 menus, signage, promotional materials, race cars, and advertising media.

18 16. Since the date of First Use of the Registered Marks, IN-N-OUT
19 BURGERS has manifested the intent to maintain exclusive ownership of the
20 Registered Marks and to continue use of the Registered Marks in interstate
21 commerce in connection with IN-N-OUT BURGERS' products and services
22 offered for sale in restaurants in California and the southwestern United States.

23 17. IN-N-OUT BURGERS has invested millions of dollars in advertising
24 its Registered Marks in the United States in an effort to create a strong association
25 between IN-N-OUT BURGERS' products and services, good will, and its
26 Registered Marks.

27 18. The Registered Marks are strong, arbitrary marks that warrant broad
28 protection in both related and unrelated product and/or service classes.

1 19. As a result of the care and skill exercised by IN-N-OUT BURGERS in
2 the conduct of its business, the high quality of IN-N-OUT BURGERS' products
3 and services offered under its Registered Marks, and the extensive advertising, sale,
4 and promotion of IN-N-OUT BURGERS' products bearing its Registered Marks,
5 its Registered Marks have acquired Secondary Meaning in the United States,
6 including in the State of California.

7 20. IN-N-OUT BURGERS was the first drive-through hamburger
8 restaurant, opened in 1948, and since then, always has operated with the drive-
9 through business at the core of its business concepts. IN-N-OUT BURGERS does
10 not place its restaurants in shopping centers, ball parks, or other such locations that
11 would detract from and which would not be conducive to the drive-in culture and
12 experience.

13 21. Since its inception, IN-N-OUT BURGERS business model has
14 focused on the car culture of California.

15 22. In keeping with the car culture business model, every year IN-N-OUT
16 BURGERS creates and sells apparel featuring a cars.

17 23. By virtue of its drive-through operations and promotions, as well as it
18 extensive sponsorship of race cars, IN-N-OUT BURGERS and its Registered
19 Marks are closely tied to the automobile culture in California and throughout the
20 country.

21 **DEFENDANTS' INFRINGING ACTIVITIES**

22 24. Defendants own and/or operate automobile service centers at several
23 locations in California, including at least the following: "IN N OUT SMOG
24 CHECK" located at 226 Phelan Avenue #F, San Jose, California 95112; "IN &
25 OUT SMOG CHECK" located at 1295 West San Carlos Street, San Jose, California
26 95126; "IN-N-OUT SMOG CHECK" located at 490 Keyes Street, San Jose,
27
28

1 California 95112; and "IN N OUT SMOG CHECK" located at 735 South 1st
2 Street, Unit A, San Jose, California 95113 ("Defendants' Locations").

3 25. Upon information and belief, each of the Defendants' Locations
4 provides automobile services to consumers in Santa Clara County, California.

5 26. IN-N-OUT SMOG CHECK has used, and continues to use, the marks
6 "IN-N-OUT," "IN N OUT," "IN AND OUT," and/or "IN & OUT" (each an
7 "Infringing Mark") in providing automobile servicing services to consumers in
8 Santa Clara County, California.

9 27. IN-N-OUT SMOG CHECK has advertised an Infringing Mark in
10 California and this Judicial District.

11 28. Each Infringing Mark constitutes a colorable imitation of IN-N-OUT
12 BURGERS' Registered Marks.

13 29. IN-N-OUT BURGERS did not authorize, and would never authorize,
14 IN-N-OUT SMOG CHECK to use any of the Infringing Marks or any other
15 colorable imitation of the Registered Marks.

16 30. IN-N-OUT BURGERS has asked IN-N-OUT SMOG CHECK to cease
17 and desist from all present and future uses of any Infringing Mark or any colorable
18 imitation of the Registered Marks. IN-N-OUT SMOG CHECK has refused.

19 **COUNT I – FEDERAL TRADEMARK INFRINGEMENT**

20 **TITLE 15 U.S.C. § 1114**

21 31. Paragraphs 1 - 30 are incorporated herein by reference.

22 32. IN-N-OUT BURGERS exclusively owns the Registered Marks.

23 33. IN-N-OUT BURGERS has used the Registered Marks in interstate
24 commerce in connection with the advertising and promotion of its restaurant goods
25 and services and financial sponsorship of automobiles and the automobile racing
26 industry.
27
28

1 34. IN-N-OUT SMOG CHECK has used a colorable imitation of the
2 Registered Marks in interstate commerce in connection with the rendering of
3 automobile servicing services at its locations in California.

4 35. Upon information and belief, IN-N-OUT SMOG CHECK's
5 unauthorized use of a colorable imitation of the Registered Marks has caused, and
6 will likely cause, confusion, mistake, or deception in the relevant consumer market.

7 36. Upon information and belief, IN-N-OUT SMOG CHECK's
8 unauthorized use of colorable imitations of the Registered Marks constitutes
9 Trademark Infringement in violation of Title 15 U.S.C. §§ 1114 and 1117.

10 37. IN-N-OUT SMOG CHECK acted in bad faith and/or willfully in
11 adopting a colorable imitation of the Registered Mark in connection with the sale of
12 the Infringement Product in an effort to reap the benefits of the goodwill associated
13 with IN-N-OUT BURGERS' Registered Marks.

14 38. IN-N-OUT SMOG CHECK's infringing acts have caused, and will
15 continue to cause, IN-N-OUT BURGERS to suffer irreparable injuries to its
16 reputation and good will. IN-N-OUT BURGERS does not have an adequate
17 remedy at law to recover for this harm, and therefore, IN-N-OUT BURGERS is
18 entitled to injunctive relief.

19 WHEREFORE, IN-N-OUT BURGERS requests judgment in its favor and
20 that is Court enter a Permanent Injunction enjoining IN-N-OUT SMOG CHECK
21 from any further use of the Infringing Marks and any further use of a colorable
22 imitation of the Registered Marks.

23 **COUNT II – FEDERAL UNFAIR COMPETITION**

24 **TITLE 15 U.S.C. § 1125**

25 39. Paragraphs 1 - 38 are incorporated herein by reference.

26 40. Upon information and belief, IN-N-OUT SMOG CHECK's
27 unauthorized use of a colorable imitation of the Marks-at-issue constitutes a false
28

1 designation of origin, a false or misleading description of fact, and/or false or
2 misleading representation of fact, and has caused and is likely to cause confusion,
3 mistake, and/or deception as to the following:

- 4 a. the affiliation, connection or association of IN-N-OUT
5 SMOG CHECK with IN-N-OUT BURGERS;
6 b. the origin, sponsorship, or approval of IN-N-OUT
7 BURGERS of IN-N-OUT SMOG CHECK; and
8 c. the nature, characteristics, or qualities of IN-N-OUT
9 SMOG CHECK's goods and services.

10 41. The aforesaid acts constitute Federal Unfair Competition in violation
11 of 15 U.S.C. § 125(a).

12 WHEREFORE, IN-N-OUT BURGERS requests judgment in its favor and
13 that is Court enter a Permanent Injunction enjoining IN-N-OUT SMOG CHECK
14 from any further use of the Infringing Marks and any further use of a colorable
15 imitation of the Registered Marks.

16 **COUNT III- TRADEMARK INFRINGEMENT (CALIFORNIA LAW)**
17 **(CAL. BUS. & PROF. CODE § 14335)**

18 42. Paragraphs 1 - 41 are incorporated herein by reference.

19 43. Section 14335 of the California Business & Professions Code
20 authorizes this Court to enjoin any infringing use of a mark registered under Title
21 15 of the U.S. Code.

22 44. The Registered Marks are registered under Title 15 of the U.S. Code.

23 45. IN-N-OUT BURGERS exclusively owns the Registered Marks.

24 46. IN-N-OUT BURGERS has used the Registered Marks in interstate
25 commerce in connection with the advertising and promotion of its restaurant goods
26 and services and financial sponsorship of automobiles and the automotive racing
27 industry.
28

1 47. IN-N-OUT SMOG CHECK has used a colorable imitation of the
2 Registered Marks in interstate commerce in connection with the rendering of
3 emissions control and smog checking services at Defendants' Locations.

4 48. Upon information and belief, IN-N-OUT SMOG CHECK's
5 unauthorized use of a colorable imitation of the Registered Marks has caused, and
6 will likely cause, confusion in the relevant consumer market.

7 49. Upon information and belief, IN-N-OUT SMOG CHECK's
8 unauthorized use of colorable imitations of the Registered Marks constitutes false
9 designation of origin, false or misleading description of fact, and/or false or
10 misleading representation of fact, and has caused and is likely to cause confusion,
11 mistake, and/or deception as to the following:

- 12 a. the affiliation, connection or association of IN-N-OUT
13 SMOG CHECK with IN-N-OUT BURGERS;
14 b. the origin, sponsorship, or approval of IN-N-OUT
15 BURGERS of IN-N-OUT SMOG CHECK; and
16 c. the nature, characteristics, or qualities of IN-N-OUT
17 SMOG CHECK's goods and services.

18 50. IN-N-OUT SMOG CHECK's false designations, descriptions, and
19 representations were made deliberately and with knowledge of their falsity.

20 51. IN-N-OUT SMOG CHECK acted in bad faith and/or willfully in
21 adopting a colorable imitation of the Registered Marks in an effort to reap the
22 benefits of the goodwill associated with IN-N-OUT BURGERS' Registered Marks.

23 52. IN-N-OUT SMOG CHECK's infringing acts have caused, and will
24 continue to cause, IN-N-OUT BURGERS to suffer irreparable injuries to its
25 reputation and good will. IN-N-OUT BURGERS does not have an adequate
26 remedy at law to recover for this harm, and therefore, IN-N-OUT BURGERS is
27 entitled to injunctive relief.
28

1 WHEREFORE, IN-N-OUT BURGERS requests judgment in its favor and
2 that is Court enter a Permanent Injunction enjoining IN-N-OUT SMOG CHECK
3 from any further use of the Infringing Marks and any further use of a colorable
4 imitation of the Registered Marks.

5 **COUNT IV – UNFAIR COMPETITION (CALIFORNIA LAW)**
6 **(CAL. BUS. & PROF. CODE § 17200)**

7 53. Paragraphs 1 – 52 are incorporated herein by reference.

8 54. IN-N-OUT BURGERS owns and enjoys rights in California and other
9 jurisdictions throughout the United States in the Marks-at-issue.

10 55. IN-N-OUT BURGERS has used the Marks-at-issue in intra and
11 interstate commerce in connection with the advertising and promotion of its
12 restaurant goods and services and financial sponsorship of automobiles and the
13 automotive racing industry.

14 56. IN-N-OUT SMOG CHECK has used a colorable imitation of the
15 Registered Marks in interstate commerce in connection with the rendering of
16 emissions control and smog checking services at Defendants' Locations.

17 57. Upon information and belief, IN-N-OUT SMOG CHECK's
18 unauthorized use of a colorable imitation of the Registered Marks has caused, and
19 will likely cause, confusion in the relevant consumer market.

20 58. Upon information and belief, IN-N-OUT SMOG CHECK's
21 unauthorized use of colorable imitations of the Registered Marks constitutes false
22 designation of origin, false or misleading description of fact, and/or false or
23 misleading representation of fact, and has caused and is likely to cause confusion,
24 mistake, and/or deception as to the following:

- 25 a. the affiliation, connection or association of IN-N-OUT
26 SMOG CHECK with IN-N-OUT BURGERS;
27 b. the origin, sponsorship, or approval of IN-N-OUT
28 BURGERS of IN-N-OUT SMOG CHECK; and

c. the nature, characteristics, or qualities of IN-N-OUT SMOG CHECK's goods and services.

59. IN-N-OUT SMOG CHECK's false designations, descriptions, and representations were made deliberately and with knowledge of their falsity.

60. IN-N-OUT SMOG CHECK acted in bad faith and/or willfully in adopting a colorable imitation of the Registered Marks in an effort to reap the benefits of the goodwill associated with IN-N-OUT BURGERS' Registered Marks.

61. IN-N-OUT SMOG CHECK's infringing acts have caused, and will continue to cause, IN-N-OUT BURGERS to suffer irreparable injuries to its reputation and good will. IN-N-OUT BURGERS does not have an adequate remedy at law to recover for this harm, and therefore, IN-N-OUT BURGERS is entitled to injunctive relief.

62. IN-N-OUT SMOG CHECK's actions constitute Unfair Competition under the Statutory Law of California, including Cal. Bus. & Prof. Code § 17200, et seq.

WHEREFORE, IN-N-OUT BURGERS requests judgment in its favor and that is Court enter a Permanent Injunction enjoining IN-N-OUT SMOG CHECK from any further use of the Infringing Marks and any further use of a colorable imitation of the Registered Marks.

COUNT V – UNFAIR COMPETITION
(CALIFORNIA COMMON LAW)

63. Paragraphs 1 – 62 are incorporated herein by reference.

64. IN-N-OUT BURGERS owns and enjoys rights in California and other jurisdictions throughout the United States in the Marks-at-issue.

65. IN-N-OUT BURGERS has used the Marks-at-issue in intra and interstate commerce in connection with the advertising and promotion of its restaurant goods and services and financial sponsorship of automobiles and the automotive racing industry.

1 66. IN-N-OUT SMOG CHECK has used a colorable imitation of the
2 Registered Marks in interstate commerce in connection with the rendering of
3 emissions control and smog checking services at Defendants' Locations.

4 67. Upon information and belief, IN-N-OUT SMOG CHECK's
5 unauthorized use of a colorable imitation of the Registered Marks has caused, and
6 will likely cause, confusion in the relevant consumer market.

7 68. Upon information and belief, IN-N-OUT SMOG CHECK's
8 unauthorized use of colorable imitations of the Registered Marks constitutes false
9 designation of origin, false or misleading description of fact, and/or false or
10 misleading representation of fact, and has caused and is likely to cause confusion,
11 mistake, and/or deception as to the following:

- 12 a. the affiliation, connection or association of IN-N-OUT
13 SMOG CHECK with IN-N-OUT BURGERS;
14 b. the origin, sponsorship, or approval of IN-N-OUT
15 BURGERS of IN-N-OUT SMOG CHECK; and
16 c. the nature, characteristics, or qualities of IN-N-OUT
17 SMOG CHECK's goods and services.

18 69. IN-N-OUT SMOG CHECK's false designations, descriptions, and
19 representations were made deliberately and with knowledge of their falsity.

20 70. IN-N-OUT SMOG CHECK acted in bad faith and/or willfully in
21 adopting a colorable imitation of the Registered Marks in an effort to reap the
22 benefits of the goodwill associated with IN-N-OUT BURGERS' Registered Marks.

23 71. IN-N-OUT SMOG CHECK's infringing acts have caused, and will
24 continue to cause, IN-N-OUT BURGERS to suffer irreparable injuries to its
25 reputation and good will. IN-N-OUT BURGERS does not have an adequate
26 remedy at law to recover for this harm, and therefore, IN-N-OUT BURGERS is
27 entitled to injunctive relief.

1 72. IN-N-OUT SMOG CHECK's actions constitute Unfair Competition in
2 violation of California Common Law of Unfair Competition.

3 WHEREFORE, IN-N-OUT BURGERS requests judgment in its favor and
4 that is Court enter a Permanent Injunction enjoining IN-N-OUT SMOG CHECK
5 from any further use of the Infringing Marks and any further use of a colorable
6 imitation of the Registered Marks.

7 **COUNT VI – DILUTION UNDER CALIFORNIA LAW**
8 **(CAL. BUS. & PROF. CODE § 14330)**

9 73. Paragraphs 1 – 72 are incorporated herein by reference.

10 74. Upon information and belief, IN-N-OUT SMOG CHECK's use of the
11 Marks-at-issue has harmed IN-N-OUT BURGERS and its business reputation and
12 has caused, and continues to cause, dilution by lessening the capacity of the Marks-
13 at-issue to identify and distinguish IN-N-OUT BURGERS' goods and services
14 from the goods and services of others.

15 75. Upon information and belief, the infringing acts of IN-N-OUT SMOG
16 CHECK has impaired, and continue to impair, the distinctive quality of the Marks-
17 at-issue.

18 76. Upon information and belief, the infringing acts of IN-N-OUT SMOG
19 CHECK have injured, and continue to injure, the business reputation of IN-N-OUT
20 BURGERS.

21 77. The foregoing infringing acts of IN-N-OUT SMOG CHECK constitute
22 actionable dilution under California Business and Professions Code §14330.

23 78. IN-N-OUT SMOG CHECK acted in bad faith and/or willfully in
24 adopting a colorable imitation of the Marks-at-issue in an effort to reap the benefits
25 of the goodwill associated with IN-N-OUT BURGERS' Marks-at-issue.

26 79. IN-N-OUT SMOG CHECK's infringing acts have caused, and will
27 continue to cause, IN-N-OUT BURGERS to suffer irreparable injuries as a result of
28 the impairment of the distinctiveness of the Marks-at-issue. IN-N-OUT BURGERS

1 does not have an adequate remedy at law to recover for this harm, and therefore,
2 IN-N-OUT BURGERS is entitled to injunctive relief.

3 WHEREFORE, IN-N-OUT BURGERS requests judgment in its favor and
4 that is Court enter a Permanent Injunction enjoining IN-N-OUT SMOG CHECK
5 from any further use of the Infringing Marks and any further use of a colorable
6 imitation of the Registered Marks.

7
8 Dated: October 23, 2007

Respectfully submitted,

9
10 By: 

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25 Attorneys for IN-N-OUT BURGERS
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28 * Motion to Admit Pro Hac Vice to be filed simultaneously.

JURY DEMAND

Plaintiff IN-N-OUT BURGER hereby demands a jury trial on all issues for which a jury trial is available.

Dated: October 23, 2007

Respectfully submitted,

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